

REMARKS

Claims 1-2, 7-14, 24-27 and 38 are presently pending. Applicants gratefully acknowledge the Examiner's indication that claims 1, 2, 7-10 and 38 have been found to be allowable over the art of record.

Claims 15-23 and 28-37 have been canceled without prejudice for being directed to a non-elected invention. Applicants reserve their right to pursue the subject matter of any of canceled claims 15-23 and 28-37, as well as any other canceled or unclaimed subject matter, in one or more divisional, continuation or continuation-in-part applications.

Claim 11 has been amended to recite that the composition is a pharmaceutical composition. Support for this amendment is found in the specification as filed at page 19, line 5. Claim 12 has been amended to recite that the condition responsive to IKK inhibition is an inflammatory condition. Support for this amendment is found in the specification as filed at page 17, lines 25-27. Claim 13 has been rewritten in independent form. Claims 14 and 27 have been amended to recite the treatment of inflammatory conditions, as previously elected. Claim 25 has been amended to correct an inadvertent typographical error and now correctly depends from claim 24. No new matter has been added.

I. Restriction of Claims 12-37

The Examiner has maintained the requirement to elect one method of use from claims 12-37. To further comply with the Examiner's requirement for restriction, Applicants have amended: claim 12 to recite a method for treating an inflammatory condition responsive to IKK-2 inhibition; and claims 13, 14, 24 and 27 to delete the recitation of an autoimmune condition. Applicants fully reserve their right to prosecute a method for treating an autoimmune condition in one or more continuation, continuation-in-part or divisional applications.

Accordingly, Applicants believe that the present restriction requirement has been fully complied with.

II. Restriction of Claims 25 and 26

The Examiner has alleged that claims 25 and 26 are outside of the elected method allegedly because their subject matter is not limited to the compounds of claim 1 since claims

25 and 26 add additional active ingredients. Applicants respectfully traverse the restriction of claims 25 and 26.

Amended claim 24, from which claims 25 and 26 depend, relates to a method for treating an inflammatory condition, comprising administering to a patient in need thereof an effective amount of a compound or pharmaceutically acceptable salt of the compound of claim 1. (Emphasis added). The transition “comprising” in a method claim is open-ended and allows for additional steps. *Invitrogen Corp. v. Biocrest Mfg. L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003).

Accordingly, the method of amended claim 24 encompasses the administration of a compound (or a pharmaceutically acceptable salt of the compound) of claim 1 and an inflammatory agent.

Moreover, a dependent claim shall be construed to incorporate by reference all of the limitations of the claim to which it refers. 35 U.S.C. § 112, fourth paragraph.

Because claims 24-26 all relate to methods for treating an inflammatory condition, comprising administering a compound (or a pharmaceutically acceptable salt of the compound) of claim 1, and the Examiner has agreed to examine claim 24 to the extent that it recites one specific method of use (Office Action, page 2, line 7), a prior-art search for the subject matter of claims 25 and 26 would not create an undue burden on the Examiner. Accordingly, Applicants respectfully request that claims 25 and 26 be examined along with elected claim 24.

III. The Rejection of Claim 12 Under 35 U.S.C. §112, First Paragraph

Claim 12 has been rejected under 35 U.S.C. §112, first paragraph, as allegedly being vague in its recitation of “a condition responsive to JNK inhibition.” The Examiner has also required the election of one specific disease.

Without in any way conceding the merits of this rejection and solely to advance the prosecution of this application, Applicants have amended claim 12 to recite “an inflammatory condition responsive to IKK-2 inhibition” (emphasis added).

Accordingly, Applicants believe that the rejection of claim 12 under 35 U.S.C. §112, first paragraph, has been overcome and must be withdrawn.

IV. The Rejection of Claim 11 Under 35 U.S.C. §112, First and Second Paragraphs

Claim 11 has been rejected under 35 U.S.C. §112, first paragraph, for allegedly not supporting the use of the composition for all purposes, and under 35 U.S.C. §112, second paragraph, for allegedly not being clear as to what the purpose of the composition is. The Examiner has suggested reciting the word “pharmaceutical” before “composition.”

Without in any way conceding the merits of this rejection and solely to advance the prosecution of this application, Applicants have amended claim 11 to recite the term “pharmaceutical” before “composition.”

Accordingly, in view of the above remarks, Applicants believe that the rejection of claim 11 under 35 U.S.C. §112, first and second paragraphs, has been overcome and must be withdrawn.

V. References BE-BG, CG and CL Cited in Information Disclosure Statement Filed August 28, 2002

Applicants acknowledge receipt of an Examiner-initialed PTO Form-1449 reciting References AA-DF. Applicants have noticed, however, that while the Examiner has placed his initials adjacent to the citation of References AA-BD, BH-CF, CH-CK and CM-DF, no initials were placed adjacent to the citation of References BE-BG, CG or CL.

Submitted herewith is a supplemental PTO form-1449 listing References BE-BG, CG and CL and providing the date of Reference CG. Accordingly, Applicants respectfully request that the Examiner make References BE-BG, CG and CL of record by reviewing the References and initializing the supplemental PTO Form-1449 submitted herewith.

VI. Conclusion

Applicants respectfully request that the present remarks be made of record in the file history of the present application. An early allowance of the application is earnestly requested. The Examiner is invited to call the undersigned with any questions concerning the foregoing.

It is believed that no fee is due other than that for the extension of time; however, in the event any other fee is required, please charge the required fee to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,

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Enclosures